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In re Application of:

KAYE, ALLAN

Serial No.: 10/525,063

Filed: Feb. 18, 2005

Docket: 540-551

DECISION ON PETITION

Title: METHOD AND TOOL FOR FORMING A
BRACKET IN COMPOSITE MATERIAL
AND BRACKET

This is a decision on the petition filed on Feb. 12, 2007 by which petitioner requests reconsideration and withdrawal of the restriction requirement mailed Jun. 8, 2006, and that non-elected claims 6-9 be rejoined and examined on the merits. Claims 1-5 and 10 were elected for prosecution. In addition, petitioner requests withdrawal of objections to the drawings and the specification in the non-final Office action dated Oct. 11, 2006. This petition is being considered pursuant to 37 CFR 1.144 and 37 CFR 1.181, and no fee is required.

The petition is **GRANTED-IN-PART**.

A review of the record reveals that on Jun. 8, 2006, a restriction requirement was made under 35 USC 121 and 372 between four disclosed and claimed inventions: I) claims 1-5 drawn to a method of forming a bracket, II) claims 6-7 drawn to a blank, III) claim 8 drawn to a bracket, and IV) claim 9 drawn to a tool for forming a bracket. This application was filed under 35 USC 371 and therefore the groups of inventions must be shown to be not so linked as to form a single general inventive concept under PCT Rule 13.1.

Petitioner argues that the examiner's rationale for restriction, i.e., "because the claims show different technical features, as stated in the Office Action filed June 8, 2006," is simply incorrect and is a statement of U.S. practice under 35 USC 111 and that the application of U.S. practice is not permitted with respect to national stage entry applications.

Relevant portions of MPEP 1850 Unity of Invention, states [emphasis added below]:

An international application should relate to only one invention or, if there is more than one invention, the inclusion of those inventions in one international application is only permitted if all inventions are so linked as to form a single general inventive concept (PCT Rule 13.1). With respect to a group of inventions claimed in an international application, unity of invention exists only when there is a technical relationship among the claimed inventions involving one or more of the

same or corresponding special technical features. The expression "special technical features" is defined in PCT Rule 13.2 as meaning those technical features that define a contribution which each of the inventions, considered as a whole, makes over the prior art. The determination is made on the contents of the claims as interpreted in light of the description and drawings (if any).

Whether or not any particular technical feature makes a "contribution" over the prior art, and therefore constitutes a "special technical feature," should be considered with respect to novelty and inventive step. For example, a document discovered in the international search shows that there is a presumption of lack of novelty or inventive step in a main claim, so that there may be no technical relationship left over the prior art among the claimed inventions involving one or more of the same or corresponding special technical features, leaving two or more dependent claims without a single general inventive concept.

Lack of unity of invention may be directly evident "*a priori*," that is, before considering the claims in relation to any prior art, or may only become apparent "*a posteriori*," that is, after taking the prior art into consideration. For example, independent claims to A + X, A + Y, X + Y can be said to lack unity *a priori* as there is no subject matter common to all claims. In the case of independent claims to A + X and A + Y, unity of invention is present *a priori* as A is common to both claims. **However, if it can be established that A is known, there is lack of unity *a posteriori*, since A (be it a single feature or a group of features) is not a technical feature that defines a contribution over the prior art.**

In judging the propriety of the restriction requirement, a lack of unity of invention must be either directly evident "*a priori*", that is, before considering the claims in relation to any prior art, or may only become apparent "*a posteriori*", that is, after taking the prior art into consideration.

The examiner indicated in the restriction requirement that the inventions listed as groups I-IV did not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features in that group I has the technical feature of curing, group II has a different technical feature of z-shaped, group III has a different technical feature of substantially planar, and group IV has a different technical feature of a hinge.

Therefore, the examiner attempted to show lack of unity of invention "*a priori*". However, the examiner's attempt to show lack of unity "*a priori*" is flawed in that the examiner relied on dependent claim 7 to show that group II has a different special technical feature of "z-shaped".

MPEP 1850 clearly states that "Unity of invention has to be considered in the first place only in relation to the *independent claims* in an international application and *not the dependent claims*." [emphasis added]. Therefore, the examiner's attempt to show lack of unity "*a priori*" was improper in that only the independent claims have to be considered.

After the examiner issued the restriction requirement and the applicant elected the group I invention (claims 1-5), the examiner issued a first action on the merits, non-final Office action dated Oct. 11, 2006. In the non-final Office action, the examiner rejected the elected independent claim 1 as being anticipated by Machida (USP 4,784,920). In addition, the examiner also rejected the elected independent claim 1 as being anticipated by Fogg III (USP 4,210,694). Claim 1 was the only independent claim in the elected group I.

Therefore, it became apparent "*a posteriori*", that is, after taking the prior art into consideration that lack of unity of invention exists. Because all of the features of claim 1 is known and does not avoid the prior art, there is no special technical feature that defines a contribution over the prior art that is common to all of the independent claims. In this situation, clearly there is lack of unity of invention.

For the reasons outlined above, the examiner's restriction requirement is considered proper. Petitioner's request to have the restriction requirement withdrawn will not be granted.

In the Oct. 11, 2006 non-final Office action, the examiner objected to the drawings as failing to comply with 37 CFR 1.84(p)(5) because figures 9 and 10 include reference characters that were not mentioned in the description. The examiner indicated that corrected drawing sheets in compliance with 37 CFR 1.121(d) or an amendment to the specification to add the reference characters in the description in compliance with 37 CFR 1.121(b) was required in reply to the non-final Office action in order to avoid abandonment of the application. In addition, the examiner indicated on pages 3-5 of the non-final Office action guidelines indicating the preferred layout of the specification.

Petitioner argues that page 9, lines 18-22 of the PCT application discusses the features in Figures 9 and 10 of the drawings. Petitioner states that each of the reference numerals utilized in Figures 9 and 10 of the drawings are discussed at the cited portions of page 9. Therefore, petitioner believes that there is no need for petitioner to add reference signs or characters to the drawings because they already exist in the formal drawings which are of record. In addition, petitioner argues that the arrangement of the specification is proper in view of PCT Article 27. Therefore, petitioner requests withdrawal of the objection to the drawings and the specification.

A review of the record reveals that petitioner submitted an amendment to pages 8 and 9 of the specification. The amended pages 8 and 9 of the specification clearly describe the reference characters shown in Figures 9 and 10 of the drawings. It appears that the amended pages 8 and 9 of the specification was mislabeled in the Image File Wrapper (IFW) of the application, thereby creating confusion as to what version of the specification should be considered. Adding to the confusion is that there are multiple versions of the specification that have been received including certain pages of the specification that have been amended. In the IFW of the application, there are four pages that have been labeled "Documents submitted with 371 Applications" which include the amended pages 8 and 9 of the specification. In order to clarify the application file record, this paper will be re-labeled "specification".

Although the examiner indicated on pages 3-5 of the non-final Office action the "preferred layout of the specification", the guidelines provided by the examiner are just the recommended layout that applicant's can use when drafting the specification and not a requirement that applicant's must follow.


Therefore, petitioner's request to withdraw the objection to the drawings and the specification is granted.

Conclusion

For the reasons outlined above, the restriction requirement issued on Aug. 15, 2006 is in accordance with proper Office procedure. Accordingly, the restriction requirement stands. The petitioner's request to withdraw the restriction requirement is dismissed. Petitioner's request to withdraw the objection to the drawings and the objection to the specification is granted.

The application is being forwarded to Supervisory Patent Examiner of Art Unit 3725 for further processing. Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision, 37 CFR 1.181(f). No extension of time under 37 CFR 1.136(a) is permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.181". Any inquiry regarding this decision should be directed to Marc Jimenez, Training Quality Assurance Specialist, at (571) 272-4530.

The petition is GRANTED-IN-PART.



Frederick R. Schmidt, Director
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